

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RESPONSE TO THE MAY 19, 2003 OFFICE ACTION

APPLICANTS: Gernot HOYLER CONFIRMATION NO.: 1423  
SERIAL NO.: 09/096,113 GROUP ART UNIT: 2123  
FILED: June 11, 1998 EXAMINER: Hugh M Jones  
TITLE: "COMPUTER-AIDED SIMULATION METHOD FOR  
DETERMINING THE ELECTROMAGNETIC FIELD OF A BODY"

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**RECEIVED**

JUN 29 2004

S I R:

Technology Center 2100

Applicant and his counsel have carefully reviewed the Office Action dated May 19, 2003, but believe the claims in their present form are supported by the specification and are patentable over the teachings of the references relied upon by the Examiner. Reconsideration of the application in view of the following remarks is therefore respectfully requested.

**REMARKS**

In the Office Action dated May 19, 2003, claim 13, 18 was rejected under 35 U.S.C. §112, first paragraph as containing subject matter that is not enabled in the present specification. The Examiner stated there does not appear to be enabling support in the specification for determining the electromagnetic compatibility of a single body.

Applicant respectfully submits this is a merely re-hash of the rejection under Section 112, second paragraph on which the Examiner was reversed by the Board of Patent Appeals and Interferences. Applicant realizes the previous rejection was based on indefiniteness, and the present rejection is based on a lack of enablement, however,

the Board's statements at pages 8 and 9 of its Decision dated November 19, 2002 are sufficiently broad to encompass, and dispose of, the present lack of enablement rejection. The Board explicitly stated, at page 8 of its opinion:

We disagree with the Examiner that based on this definition, the "electric compatibility" of the single body cannot be determined. As long as the potential effect of the body on its environment can be determined, we do not find any requirements in the above definition for determining compatibility with respect to another body, as suggested by the Examiner.

At the top of page 9 of its Decision, the Board stated:

In view of our analysis above and in light of the specification as a whole, we find that the terms "stability of said body" and "electromagnetic compatibility of the body" are sufficiently defined and would reasonably apprise those skilled in the art of the scope of these limitations.

This is a sufficiently broad statement to encompass any lack of enablement rejection. It is not understood how the Examiner could make the aforementioned indefiniteness rejection without at the same time raising a lack of enablement rejection, if that had been proper. This application has been pending for over six years and now, for the first time, the Examiner is recasting the aforementioned indefiniteness rejection in terms of lack of enablement. The Examiner is precluded from doing so at this time by the Board's decision, which completely and fully responds to, and disagrees with, the alleged lack of enablement raised by the Examiner in the latest Office Action. The Examiner is not permitted to ignore, or even disagree with, the Board's conclusions on this point. The Board's decision sets forth the applicable standards for all further prosecution.

Additionally, claims 1, 4, 6-8, 14 and 19 were rejected under 35 U.S.C. §102(b) as being anticipated by Song et al. Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Song et al in view of Marshall.

Again, Applicant respectfully submits the Examiner is merely substituting a different reference for the references that were previously relied upon by the Examiner, with no significant differences between the teachings of those references, and therefore the reversal by the Board of the Examiner's previous rejection precludes the Examiner from making the same, or substantially the same, rejection based on the Song et al reference.

Regardless of the Examiner's statements regarding the teachings of the Song reference, it is clear, as before, the Examiner made no effort to identify any specific teachings therein that relate the teachings of that reference to the global and local multipole expansion and superpositioning of the results of those expansions for stimulating an electromagnetic field of a body. As explicitly stated in the last paragraph at page 10 of its opinion, the lack of these teachings in the references previously relied upon by the Examiner was the reason why the Board reversed the previous rejections under Section 102 and Section 103. In the latest Office Action, the Examiner has not even mentioned global expansion or multipole expansion in the substantiation of the rejection. The Examiner has merely made a statement regarding the Examiner's characterization or summary of the teachings of the Song et al reference, and, without substantiation, has stated that this anticipates the subject matter of claim 1. At a minimum for anticipation, it is necessary that the Examiner identify and correlate a teaching in the allegedly anticipating reference with regard to each significant claim limitation of the claim in question. The Examiner did not do so before and has not done

so now, and therefore the present rejection is no different from the previous rejections that were reversed by the Board.

The deficiencies in the Examiner's previous rejections were thoroughly addressed by the Board, and the Examiner has not presented another rejection which embodies exactly those same deficiencies. It is as if the Examiner has not even bothered to read, or at least take seriously, the Board's decision. In the present circumstances, it is not only incumbent on the Examiner to make a properly substantiated rejection, but it is incumbent on the Examiner to demonstrate why any new rejection does not suffer from the same deficiencies as the previous rejections that were reversed by the Board. The Examiner has done neither.

The Song et al reference does not disclose all of the elements of claim 1 as arranged and operating in that claim, for the above reasons, and therefore does not anticipate claim 1, nor any of claims 4, 6-8, 14 or 19 depending therefrom.

The lacking teachings in the Song et al reference are not supplied by, or remedied by, the additional reliance on the Marshall reference. Therefore, even if the Song et al reference were modified in accordance with the teachings of Marshall, the subject matter of claim 13 still would not result. Claim 13, therefore, would not have been obvious to a person of ordinary skill in the art under the provisions of 35 U.S.C. §103(a) based on the teachings of Song et al and Marshall.



All claims of the application are therefore submitted to be in condition for allowance, and early reconsideration of the application is respectfully requested.

Submitted by,

*Bruce A. Valdez* (Reg. 27,841)

SCHIFF, HARDIN LLP  
**CUSTOMER NO. 26574**  
Patent Department  
6600 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606  
Telephone: 312/258-5790  
Attorneys for Applicant.

CH1\ 4155402.1